

**REMARKS/ARGUMENTS**

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 1-4, 6-10, 12-16, 18-22, and 24-49 are pending in the application. Claims 13-16 and 35-39 have been amended. No further claims have been canceled. Claims 48 and 49 are new claims.

**35 U.S.C. § 101 Rejections**

Claims 13-16, 18, and 35-39 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed. The Examiner has objected to each instance of “means for” as potentially invoking non-statutory software *per se*. In order to expedite prosecution, Applicant has amended each instance of “means for” to “hardware means for” in the claims at issue. Accordingly, Applicant respectfully requests that the rejections of claims 13-16, 18, and 35-39 under 35 U.S.C. §101 be withdrawn.

**35 U.S.C. § 103 Rejections – *Hall, Eaton, Keating***

Claims 1-4, 6-10, 12-16, 18-22, and 24-44 and 46 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Hall et al. (U.S. Patent No. 6,032,051) in view of Eaton et al. (U.S. Patent Publication No. 2003/0208545) and in further view of Keating et al. (U.S. Patent Publication No. 2004/0082352). Initially, Applicant notes that claims 45 and 47 are listed as being rejected in view of Hall, Eaton, and Keating under the heading of paragraph 4 of the Office Action, but no rejection in view of these references is subsequently made. Because claims 45 and 47 are rejected elsewhere in view of additional references, their listing in the heading of paragraph 4 of the Office Action has been treated as a typographical error. Applicant respectfully

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traverses the rejection of claims 1-4, 6-10, 12-16, 18-22, and 24-44 and 46 for at least the following reasons.

MPEP 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the recently published "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", (hereinafter "KSR Guidelines") further supports the basic requirement for a finding of obviousness as clearly articulated in the following:

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The 35 U.S.C. § 103(a) obviousness rejection of claims 1-4, 6-10, 12-16, 18-22, and 24-44 and 46 is improper because the elements for a *prima facie* case of obviousness are not met.

Applicants' independent claim 1, for example, is directed to sharing user information in a wireless communication network outside of a call setup, including sending an alert from an originator to a group communication server (GCS), the alert including presence information about the originator and requesting presence information about a target, "*transmitting an alert from the GCS to the target,*" and receiving information by the originator from the GCS containing information about the target in response to the alert. Independent claims 7, 13, 19, 25, 30, 35, and 40 recite similar features. Applicant respectfully submits that Hall, Eaton, and Keating, either alone or in combination, fail to teach or suggest at least the above quoted feature of the independent claims, as detailed below.

The Examiner acknowledges that Hall does not teach a group communication server, or communications between mobiles and a group communication server, but relies on Eaton, and specifically paragraph [0010], lines 1-23 of Eaton, as teaching features of the claimed invention involving a group communication server.

In the cited section, Eaton states:

In order to utilize instant messaging, an instant message device is pre-configured with, or the user installs, application client software distributed by a particular service provider. The client software connects to a server for communication. To access the server, via a logon procedure, the client sends the routing information (e.g. IP address and number of the port assigned to the client, mobile phone number) of the instant message device being used, the account user's username, the account user's password, and the account user's current availability setting to the server. The server temporarily stores the routing and availability information for the account user's device. In response to the account user's login information (username and password), the server provides the messaging client with the account user's contact list. The server then determines the presence and availability of the account users in that contact list. If the server finds any of the contacts logged in (i.e. presence setting is online), it sends a message back to the messaging client on the instant message device with the presence and availability information for that account user. The server also sends the account user's presence and availability

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information to the people that have the account user in their contact list. (Eaton, paragraph [0010].)

From this passage, the Examiner alleges that “in order for the server to receive the presence information about account users in the contact list said server will need to communicate with said account users.” (Office Action, pg. 5.) Even if the Examiner is correct, the necessity of “communication” does not imply the manner in which the presence information of each user in the contact list is obtained. While Applicant agrees that some form of communication with the users in the contact list at some point in time is needed for the server in Eaton to obtain their presence information, there is simply no indication in Eaton that such a communication involves transmitting an alert to each account user in the contact list. Eaton merely states that “[t]he server then determines the presence and availability of the account users in that contact list.” This does not imply that presence information is requested in an alert from the server to each user in the contact list. Determining presence information can be performed in many ways without actively transmitting alerts to various users inquiring about their status when new logins are commenced. For example, these determinations can be made according to a stored table or list maintained by the server in response to voluntary status updates from the various users (e.g., status updates upon login/logout procedures initiated by the user device).

In fact, the only mention in the cited passage of the server actually receiving presence information from a user is when the instant messaging device voluntarily sends the server its own presence information at login. This suggests that presence information is not requested in an alert from the server, but is submitted at the discretion of the individual devices. In the instant messaging environment of Eaton, it seems wasteful of system resources and/or bandwidth to constantly query devices as the Examiner implies, especially when the presence information of many of those devices remains essentially static over a long period of time, and when each user contact list may contain hundreds or thousands of entries.

Moreover, Eaton teaches that the voluntarily submitted presence information is stored and disseminated as an update to other users. This suggests that the server in Eaton does indeed maintain some sort of stored table or list of device presence information. Accordingly, without explicit teachings to the contrary, it seems more reasonable that presence information for each user in a given contact list is determined in Eaton by retrieving it from a memory maintained at the server, not by actively querying each device through transmitting an alert. Applicant acknowledges that Eaton only discloses “temporarily” storing the presence information received from a user during login. However, in context the term “temporarily” is equally applied to the routing information (e.g., IP address) corresponding to the user’s device. (“The server temporarily stores the routing and availability information for the account user’s device.”) It is highly doubtful that the server would delete the IP address of a device with which the server intends to continue actively communicating, and it is therefore clear that the term “temporarily” as applied in this context means throughout the duration of the user’s connection with the server (i.e., until the user logs out or the session is otherwise terminated).

Thus, there is simply no indication in Eaton that a group communication server transmits an alert to a target whose presence information is being requested as in the claimed invention. To the contrary, Eaton suggests that when presence information about a target is requested by an originator, the server responds with pre-stored information maintained at the server based on voluntarily submitted status updates.

For at least the foregoing reasons, it is respectfully submitted that claims 1, 7, 13, 19, 25, 30, 35, and 40 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. *See* MPEP § 2143.01.

Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination. For example, claim 48 explicitly recites “wherein transmitting the alert from the GCS to the target is performed in response to the request for presence information about the target.” Even if Eaton were construed as teaching transmitting an alert to a contact list user by the server at some point in time during its operation, Eaton fails to teach or suggest transmitting the alert in response to any request for presence information by another user.

As a further example, claim 49 explicitly recites “wherein sending the alert from the originator to the GCS is performed subsequent to completing a call setup for the originator.” By contrast, Eaton as applied is directed to an initial login procedure, (i.e., a call setup operation). Keating is also directed to operations within a call setup, and relies exclusively on the process of setting up a call to initiate operation of the disclosed dispatch application processor (DAP) and query invited participants. The proposed combination therefore at least changes the principle of operation behind the teachings of Keating whereby potential participants are queried through the call setup procedure itself. The Examiner’s defense that “Keating and Hall both teach a wireless talk group system in which a user, who initiates a group session, can determine the status or presence information of other group members” (Office Action, pg. 2) merely addresses whether the two references are analogous, but fails to show that the manners in which they achieve their intended results (i.e., the principle behind their operations) are congruent. It is a well known tenet of U.S. patent law that if the proposed modification of a reference would change the principle of operation of the reference’s invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP § 2143.01. See also the KSR Guidelines,

referenced above, requiring that “each element merely would have performed the same function as it did separately.”

**35 U.S.C. § 103 Rejections – *Hall, Eaton, Keating, Salmi***

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of Eaton and Keating, and in further view of U.S. Patent Publication No. 2003/0037103 to Salmi et al. (hereinafter “Salmi”). Applicants respectfully traverse this rejection, as detailed below.

Salmi fails to cure the deficiencies of Hall, Eaton, and Keating discussed above with regard to independent claim 1. Thus, Applicants submit that independent claim 1 is patentable over Hall in view of Eaton and Keating, and in further view of Salmi. Accordingly, the patentability of independent claim 1 precludes a rejection of claim 45 depending therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. *See In re Fine*, 5, USPQ.2d 1596, 1600 (Fed Cir. 1988); *see also* MPEP § 2143.03.

Therefore, Applicants respectfully request that this rejection of dependent claim 45 under 35 U.S.C. § 103(a) be withdrawn.

**35 U.S.C. § 103 Rejections – *Hall, Eaton, Keating, Berger***

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of Eaton and Keating, and in further view of U.S. Patent Publication No. 2004/0267887 to Berger et al. (hereinafter “Berger”). Applicants respectfully traverse this rejection, as detailed below.

Berger fails to cure the deficiencies of Hall, Eaton, and Keating discussed above with regard to independent claim 1. Thus, Applicants submit that independent claim 1 is patentable over Hall in view of Eaton and Keating, and in further view of Berger. Accordingly, the patentability of independent claim 1 precludes a rejection of claim 45 depending therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. *See In re Fine*, 5, USPQ.2d 1596, 1600 (Fed Cir. 1988); *see also* MPEP § 2143.03.

Therefore, Applicants respectfully request that this rejection of dependent claim 47 under 35 U.S.C. § 103(a) be withdrawn.

**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

**Deposit Account Authorization**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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